



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/728,951

12/08/2003

Kouichi Sugiyama

00862.023356.

9003

5514

7590

09/04/2008

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

THOMAS, ASHISH

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

09/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,951	<b>Applicant(s)</b> SUGIYAMA, KOUICHI	
	<b>Examiner</b> ASHISH K. THOMAS	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 8 and 10-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-8, 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 7, 8, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda(U.S. 6,267,517) in view of Barry(U.S. 5,859,711).

Regarding claim 1, Noda teaches a method of controlling printing in an information processing apparatus(**Print server 208 in figure 1**) communicating with a printing apparatus(**Printer 220 in figure 1**), comprising: a first generation

Art Unit: 2625

step of generating combination print data by combining each print data included in a plurality of print jobs, the plurality of print jobs including print data for printing pages of a document and banner print data for banner printing respectively.

**(Column 5, lines 10-30 details a method that combines print jobs. This reads on the first generation step. Note that the reference mentions the concept of banner print data as well.)**

But Noda is silent on a second generation step of generating new banner print data, which is different from each banner print data included in the plurality of print jobs, for the combination print data generated in the first generation step; and a third generation step of newly generating a single print job including the combination print data generated in the first generation step and the new banner print data generated in the second generation step.

Barry, on the other hand, discloses a second generation step of generating new banner print data, which is different from each banner print data included in the plurality of print jobs, for the combination print data generated in the first generation step**(Column 18, lines 40-47 teaches a separator page for a stack of print jobs. This reads on the second generation step of generating new banner print data.)**; and a third generation step of newly generating a single print job including the combination print data generated in the first generation step and the new banner print data generated in the second generation step. **(Column 18, lines 40-47 discloses a stack of print jobs, separator pages, and a separator for the entire stack. This in turn teaches the third generation step.)**

Art Unit: 2625

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda with Barry to fully put forth the method claimed in claim 1.

The motivation behind this modification is to yield a method that would properly identify a combined print job. This way, a user can easily understand what is contained in the combined job set. Noda and Barry references are combinable because both discuss the concept of combining print jobs.

Regarding claim 2, Noda further teaches a method wherein, in the first generation step the combination print data is generated by disabling data on execution of banner printing included in the plurality of print jobs. **(Column 5, lines 25-28 teaches that only one banner page is made for the combined print jobs. This inherently teaches that the printing of banner page for each of the plurality of print jobs is not performed.)**

Regarding claim 7, it is rejected in the same manner as claim 1. Note that claim 7 teaches an apparatus that corresponds to the method stated in claim 1.

Regarding claim 8, it is rejected in the same manner as claim 1. Note that claim 8 teaches a computer readable storage that stores a program that executes the method stated in claim 1.

Regarding claim 10, Noda further teaches the method wherein the banner print data is data indicating designation of banner printing or banner pages. **(Column 5, lines 1-10 teaches the creation of the banner page. It also teaches the type of data contained in the banner page.)**

Art Unit: 2625

Regarding claim 11, it is rejected in the same manner as claim 2. Note that claim 11 teaches an apparatus that corresponds to the method stated in claim 2.

Regarding claim 13, it is rejected in the same manner as claim 10. Note that claim 13 teaches an apparatus that corresponds to the method stated in claim 10.

4. Claims 3, 12, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda(U.S. 6,267,517) in view of Barry(U.S. 5,859,711) and further in view of well known prior art(official notice).

Regarding claim 3, Noda and Barry teach the subject matter detailed in claim 1.

But Noda and Barry are silent on a setting step of setting layout information on a number of pages laid out on a print sheet for the single print job, wherein the layout information is applied to the combination print data without being applied to the banner print data, and the single print job is outputted to the printing apparatus in the output step.

It is well known in the art(**official notice**) that the layout information for the document part of the print job can be different from the banner portions of the print job.

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda and Barry with well known prior art to fully realize the method stated in claim 3.

Art Unit: 2625

The motivation is to differentiate the banner portion of the print job for stylistic reasons.

Regarding claim 12, it is rejected in the same manner as claim 3. Note that claim 12 is an apparatus claim that corresponds to the method claim stated in claim 3.

Regarding claim 15, Noda and Barry teach the subject matter detailed in claim 1.

But Noda and Barry are silent on a method wherein the new banner print data includes data of a user that instructs the print and data of the print time.

Note that it is a well known concept in the art (official notice) that banner data usually contains user information as well as other information such as print time.

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda and Barry with well known prior art to fully realize the method stated in claim 15.

The motivation behind this modification is to yield a method that would properly identify a combined print job. This way, a user can easily understand what is contained in the combined job set.

Regarding claim 17, it is rejected in the same manner as claim 15. Note that claim 17 teaches an apparatus that corresponds to the method stated in claim 15.

Art Unit: 2625

5. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda(U.S. 6,267,517) in view of Barry(U.S. 5,859,711) and further in view of Fischer(U.S. 6,373,588).

Regarding claim 14, the combination of Barry and Noda teaches the subject matter claimed in claim 1.

But Barry and Noda do not teach a method wherein in the second generation step, each banner print data included in the plurality of print jobs are deleted and the new banner print data is generated.

Fischer, on the other hand, teaches a method wherein, in the second generation step, each banner print data included in the plurality of print jobs are deleted and the new banner print data is generated. **(Column 10, lines 14-26 teaches a step that deletes the banner data for a plurality of MOPY print jobs and only maintains one banner sheet.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda and Barry with Fischer to fully put forth the method claimed in claim 14.

The motivation behind this modification is to put forth a banner printing method that clearly identifies to the user the print job by having only one banner print sheet as opposed to having a plurality of banner sheets that could confuse the user.

Regarding claim 16, it is rejected in the same manner as claim 14. Note that claim 16 teaches an apparatus that corresponds to the method stated in claim 14.



Art Unit: 2625

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHISH K. THOMAS whose telephone number is (571)272-0631. The examiner can normally be reached on 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ashish K Thomas/  
Examiner, Art Unit 2625

/Mark K Zimmerman/

Supervisory Patent Examiner, Art Unit 2625